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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/676,508	09/30/2003	Nicholas Shifan	16222U-015510US	8563
66945 7590 09/26/2008 TOWNSEND AND TOWNSEND CREW LLP TWO EMBARCADERO CENTER, 8TH FLOOR SAN FRANCISCO, CA 94111				
EXAMINER				
PARIKII, HARSHAD R				
ART UNIT		PAPER NUMBER		
3687				
MAIL DATE		DELIVERY MODE		
09/26/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/676,508

Applicant(s)

SHIFTAN ET AL.

Examiner

HARSHAD PARIKH

Art Unit

3687

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 7/16/2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-183 is/are pending in the application.

4a) Of the above claim(s) 1-86,89-90,92-94,100,103-111,113,115-127,132-174 is/are withdrawn from consideration.

- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 87-88,91,95-99,101-102,112,114,128-131,175-183 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This Office action responds to the amendment and arguments filed by applicant on July 16, 2008 in reply to the previous Office action on the merits, mailed April 16, 2008.

Prosecution History Summary

- Claims 87-88 (2), 91 (1), 95-99 (5), 101-102 (2), 112 (1), 114 (1), 128-131 (4) and 175-183 (9) are pending (Total 25 claims) in the instant application.
- Claims 87-88 (2), 91 (1), 95 (1), 97(1), 99(1), 101 (1), 112 (1), 114 (1) and 128-131(4) are "currently amended". (Total 13 claims)
- Claims 96, 98 and 102 are "original". (Total 3 claims)
- Claims 175-183 are new claims. (Total 9 claims)
- Claims 1-86 (86), 89-90 (2), 92-94 (3), 100 (1), 103-111 (9), 113 (1), 115-127 (13) and 132-174 (43) are now "cancelled" (Total 158 claims).
- Claims 1-174 (174) were pending before this amendment.

Response to Amendment

The amendment of claims 87-88 (2), 91 (1), 95 (1), 97(1), 99(1), 101 (1), 112 (1), 114 (1) and 128-131(4) by applicant, in the reply filed on July 16, 2008, is hereby

acknowledged. New claims 175-183 by applicant, in the reply filed on July 16, 2008, is also hereby acknowledged.

Claim Rejections - 35 USC § 112, Second Paragraph

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 182-183 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The primary purpose of this requirement of definiteness of claim language is to ensure that the scope of the claims is clear so the public is informed of the boundaries of what constitutes infringement of the patent. A secondary purpose is to provide a clear measure of what applicants regard as the invention so that it can be determined whether the claimed invention meets all the criteria for patentability and whether the specification meets the criteria of 35 U.S.C. 112, first paragraph with respect to the claimed invention. In the instant invention, it is unclear when the "providing the electronic receipt to the portable device" step is occurring. It is unclear if said step is occurring before the electronic receipt is being verified or after the electronic receipt is being verified.

The Examiner notes, the court held that it was improper to read a specific order of steps into method claims where, as a matter of logic or grammar, the language of the

method claims did not impose a specific order on the performance of the method steps, and the specification did not directly or implicitly require a particular order.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 182 and 183 are rejected under 35 U.S.C. 101 based on Supreme Court precedent, and recent Federal Circuit decisions, the Office's guidance to examiners is that a § 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780,787-88 (1876).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state. Here, applicant's method steps, fail the first prong of the new Federal Circuit decision since they are not tied to another statutory class and can be preformed without the use

of a particular apparatus. Thus, claims 182 and 183 are non-statutory since they may be preformed within the human mind.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 87-88, 91, 95-99, 101-102, 112, 114, 128-131 and 175-183 are rejected under 35 U.S.C. 102 (b) as being anticipated by Pitroda et al. (US 5,590,038), hereinafter referred to as Pitroda.

Referring to claim 87, Pitroda discloses a system for managing electronic receipts, comprising:

a base device (See Pitroda: Fig 2: Main control computer (26) and POS (23)) communicatively coupled to a portable device (See Pitroda: Fig 2: UETC), the base device associated with an identifier, the base device storing a plurality of electronic receipt policies, the base device generating an electronic receipt corresponding to a transaction using a select policy (See also: Col 6: Lines 10-25 Health insurance coverage policy) of the plurality of electronic receipt policies and the base device forwarding the generated electronic receipt to devices the portable device for storage;

wherein, which one of the plurality of policies is the select policy used for generating that the electronic receipt depends on the transaction. (See Pitroda: Fig 4 and 14)

Referring to claim 88, Pitroda discloses the system of claim 87 wherein the select policy is associated with a service provider associated with the transaction. (See Pitroda: Fig 4 and 14, Col 6: Lines 15-40)

Referring to claim 91, Pitroda discloses the system of claim 87 wherein an administration system provides at least one of the plurality of electronic receipt policies. (See Pitroda: Fig 2, 4, 14 and 30)

Referring to claim 95, Pitroda discloses the system of claim 87 wherein each administration system of a plurality of administration systems communicating with the base device provides at least one of the plurality of policies to the base device to allow the base device to generate electronic receipts accordingly. (See Pitroda: Col. 2, Lines 60-65)

Referring to claim 96, Pitroda discloses the system of claim 95 wherein each administration system periodically updates at least one of the plurality of policies and forwards the at least one updated policy to the base device. (See Pitroda: Col. 2, Lines

60-65)

Referring to claim 97, Pitroda discloses the system of claim 95 wherein the base device is further configured to store a copy of the electronic receipt generated by the base device in a local receipt storage. (See Pitroda: Fig 2: Items 23 and 29)

Referring to claim 98, Pitroda discloses the system of claim 97 wherein contents of the local receipt storage are periodically uploaded to one of the plurality of administration systems. (See Pitroda: Col. 5, Lines 25-40)

Referring to claim 99, Pitroda discloses the system of claim 97 wherein a user of the portable device is able to use the base device to restore a deleted electronic receipt on that portable device by using contents of the local receipt storage. (See Pitroda: Fig 2) (The user can access the main central computer from UETC or PC using main central computer (25) at any time (Fig 2))

Referring to claim 101, Pitroda discloses the system of claim 95 wherein the base device is further configured to store historical activity information relating to a plurality of electronic receipts generated by the base device in a local receipt activity log. (See Pitroda: Fig 2: Item 29: Transaction, time stamp and type of activity)

Referring to claim 102, Pitroda discloses the system of claim 101 wherein contents of the local receipt activity log are periodically uploaded to one of the plurality of administration systems. (See Pitroda: Fig 2: Items 23 and 29)

Referring to claim 112, Pitroda discloses the system of claim 87 wherein the plurality of electronic receipt policies correspond to a plurality of different service providers. (See Pitroda: Fig 4 and 14, Col 6: Lines 15-40)

Referring to claim 114, Pitroda discloses the system of claim 87 wherein information relating to the identifier is incorporated into the electronic receipt generated by the base device. (See Pitroda: Col. 6, Lines 15-40)

Referring to claim 128, Pitroda discloses the system of claim 87 wherein the electronic receipt is tamper-proof. (See Pitroda: Col. 6, Lines 15-40)

Referring to claim 129, Pitroda discloses the system of claim 87 wherein the electronic receipt includes a validity period. (See Pitroda: Col. 6, Lines 15-40)

Referring to claim 130, Pitroda discloses the system of claim 87 wherein the electronic receipt includes receipt status information. (See Pitroda: Col. 6, Lines 15-40)

Referring to claim 131, Pitroda discloses the system of claim 87 the electronic receipt includes transaction identifying information. (See Pitroda: Col. 6, Lines 15-40)

Referring to claim 175, Pitroda discloses the system of claim 87 wherein a user manages a plurality of electronic receipts with a user device (See Pitroda: Fig 2 Item 24) communicating with the portable device, wherein the plurality of electronic receipts includes the generated electronic receipt. (See Pitroda: Fig 2 Item 24 and UETC)

Referring to claim 176, Pitroda discloses the system of claim 87 wherein an administration system determines the select policy from the plurality of electronic receipt policies and downloads the select policy to the base device, the select policy corresponding to a service provider associated with the transaction. (See Pitroda: Fig 2 Items 26 and 27, Col 6: Lines 15-40)

Referring to claim 177, Pitroda discloses a method of managing electronic receipts, comprising:

receiving a plurality of electronic receipt policies from one or more administrative systems, the plurality of electronic receipt policies corresponding to different service providers; (See Pitroda: Fig 2 Items 26, 27 and 29, Col 6: Lines 15-40)

selecting a policy used to generate an electronic receipt associated with a transaction, the selected policy corresponding to a service provider associated with the transaction; (See Pitroda: Fig 2 Items 26, 27 and 29, Fig 4 and 14, Col 6: Lines 15-40)

generating an electronic receipt using the selected policy; (See Pitroda: Fig 23)
and

forwarding the generated electronic receipt to a portable device communicating with the base device for receipt management. (See Pitroda: Fig 20, 21 and 23)

Referring to claim 178, Pitroda discloses the method of managing electronic receipts of claim 177 wherein receipt management comprises receipt duplication, receipt storage, receipt sharing, receipt deletion, and receipt restoration by a user. (See Pitroda: Fig 20 and 24)

Referring to claim 179, Pitroda discloses the method of managing electronic receipts of claim 177 wherein receipt management comprises deletion, by a base device, of an electronic receipt stored on the portable device if the electronic receipt is invalid or confirmed for deletion. (See Pitroda: Fig 23) (Provided the receipt is still on portable device)

Referring to claim 180, Pitroda discloses the method of managing electronic receipts of claim 177 further comprising automatically deleting the generated electronic receipt on the portable consumer device upon the end of a validity period. (See Pitroda: Fig 23) (Provided that it has "time based delete" feature when receipt was originally generated) (Provided the receipt is still on portable device)

Referring to claim 181, Pitroda discloses the method of managing electronic receipts of claim 177 further comprising automatically deleting the generated electronic receipt on the portable consumer device if the electronic receipt is confirmed for deletion. (See Pitroda: Fig 23) (Provided the receipt is still on portable device)

Referring to claim 182, Pitroda discloses a method of managing electronic receipts, comprising:

identifying an electronic receipt of a plurality of electronic receipts on a portable device using an identifier associated with a base device used in an associated transaction; (See Pitroda: Fig 23, 26, 27, 29, Col 6: Lines 15-40)

verifying the electronic receipt; and (See Pitroda: Fig 23, 26, 27, 29, Col 6: Lines 15-40)

providing the electronic receipt to the portable device. (See Pitroda: Fig 23, 26, 27, 29, Col 6: Lines 15-40)

Referring to claim 183, Pitroda discloses the method of managing electronic receipts of claim 182, wherein verifying the electronic receipt comprises:

validating the electronic receipt; (See Pitroda: Fig 23, 26, 27, 29, Col 6: Lines 15-40) and

verifying user access to the electronic receipt. (See Pitroda: Fig 23, 26, 27, 29, Col 6: Lines 15-40)

Response to Arguments

Applicant's arguments filed on **07/16/2008** with respect to the pending claims were considered but are not persuasive.

Section 102 Rejections:

The Applicants argue and believe that Pitroda et al does not read upon claims 87, 91, 95-99, 101- 102, 112, 114, and 128-131, as amended.

The Examiner notes, Pitroda discloses a system that anticipates the above mentioned claims. The details are given in 102 rejections section.

New Claims 175-183

Examiner has carefully reviewed new claims 175-183. These claims have been rejected as discussed above.

The Applicants argue that applicant cannot find any related description in Pitroda related to electronic receipt policies from administrative system corresponding to different service providers and utilizing the proper policy.

The Examiner notes, Pitroda discloses a system that connects UETC through CIU at either POS or PC to get connected to the main central computer and its resources including getting connected to the proper service provider. Hence, the policy and related details for all providers and customers is available to computer 26. (This information may be resident on 27 or 29 also). The system has access to all the policy

details (credit limit, expiry date, discount, validity of receipt, etc.) to authorize the transaction, generate the receipt and pass it on to UETC.

The Applicants argue that applicant cannot find any related description in Pitroda related to identification of an electronic receipt from the portable device using base device identification for further verification.

The Examiner notes, Pitroda discloses a system that has receipts stored on UETC with all the details including POS identification. POS identification is one of the basic details of any receipt when generated. The user can go to any POS for either exchange or return of the goods/services and when it gets connected to POS and the system, all the details of the transaction are available to the system for all the manipulation. It should be noted that the system reads all the personal and account information from UETC. Any attribute from the receipt is readable by the system. Receipts and its information with different attributes can be easily downloaded from UETC to any PC for accounting purposes. Similarly, the information related to receipts from UETC can be read by the system for any purpose.

Furthermore, the applicant states "Applicants respectfully submit that Pitroda et al. fails to teach or suggest the elements specifically recited in Claim 175 and its dependent claims."

The Examiner notes, that dependent claim 175 has no more dependent claims at all.

Furthermore, the applicant states "as recited in independent Claim 175." The Examiner notes, that claim 175 is a dependent claim.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **HARSHAD PARIKH** whose telephone number is (571)270-5468. The examiner can normally be reached on Monday through Thursday 9 AM-5 PM (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew S Gart can be reached on 571-272-3955. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Matthew S Gart/
Supervisory Patent Examiner, Art
Unit 3687

/HRP/
Sep 19, 2008